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09/660,433	09/07/2000	Kip Van Steenburg	7175/65430	6205
7590	04/20/2005			EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on January 29, 2004, a supplemental Examiner's Answer is set forth below:

The BPAI has asked the examiner to reconsider the rejection under 35 U.S.C. §251 is still applicable in view of the precedential opinion set forth in Ex parte Eggert, 67 USPQ2d 1716. Upon review of Ex parte Eggert the examiner has decided that the rejection is still proper and should be upheld for the following reasons.

Background

The applicant filed a reissue application with claims 1-100. Claims 1-13 are identical to claims 1-13 that were allowed in the original application 08/813,708. In the reissue application 09/550,433, newly added claims 14-100 attempt to recapture subject matter surrendered in the original application. The appeal before the Board of Patent Appeals and Interference (BPAI) appeals the decision from the Examiner to reject claims 14-100 under 35 USC 251 as recapture. No other issues are present in the appeal.

Reissue independent claims 14, 24, 48, 72, 81, 91 were added in the reissue application. In the following analysis of whether the reissue claims are impermissibly broadened (by removing limitations that were surrendered during prosecution by way of amendment and argument in order to define over the applied prior art), reference will be made to the independent claim 14 alone, because the argument is equally applicable to the remainder of the independent claims.

In the reissue declaration, the Inventor states:

"I request that I be permitted to amend the '641 PATENT and be granted a reissue patent; that errors rendering the '641 patent wholly or partly inoperative or invalid caused the claims of such patent to be of more narrow scope than necessary to distinguish over the prior art; and that such errors arose without any deceptive intent."

"Specifically, I at least claimed less than I had a right to claim in '641 PATENT by limiting patent claim 1 to the supporting device to one with a longitudinal axis and the clamping device having an axis transverse to the longitudinal axis."

As will be shown below, not only is this argument factually incorrect, and it also distracts the attention away from the main limitation that was added during prosecution in order to define over the prior art.

In the prosecution of the original application (08/813,708), the examiner rejected claim 1 as being anticipated by Klevstad 4,426,071. The rejection stated "Note that these axes are transverse to one another" (paper no. 3, p. 3,1.12). In his attempt to define over the applied prior art, Applicant amended claim 1, to read (paper no. 4, p. 2,11.2-9):

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"a clamping device for mounting [the] a proximate end of said support device to a mounting device having a first axis transverse to said longitudinal axis and selectively simultaneously clamping and releasing motion of said support device about said first axis and about said second axis transverse to both said first axis and said longitudinal axis, said support device fixed in said clamping device from rotation about said longitudinal axis."

The disclosure that supports the claims is clear and specific about this limitation (see the '641 patent, col. 4, lines 33-36):

"Thus with one action, the rotation of handle 18 about axis 80, the clamp releases its grip to allow rotation about both axis 36 and axis 72 to provide simultaneous repositioning in the abduction and lithotomy dimensions."

In paper no. 4, p. 4, lines 22-27, Applicant argued in what sense the above amendment defined over the applied prior art:

"Klevstad does not teach an actuator device that simultaneously selectively clamps and releases the support device and the mounting device to allow movement of the support device jointly about first and second axes transverse to the longitudinal axis of the support device and to each other."

Hence, from the specification, the construction of the claim, the amendment and the accompanying arguments, it is clear that the invention was claimed (as amended) to selectively clamp and selectively release the support device and the mounting device to control movement, or lack thereof, of the support device simultaneously (i.e., occurring at the same time or concurrently) about first and second axes transverse to the longitudinal axis of the support device and to each other.

In the rejection of the reissue application, the examiner had rejected the reissue claims by noting that the Applicant was attempting to remove said limitations, particularly the reference to the transverse axes and simultaneity of movement or lack thereof relative to said transverse axes (see, Application 09/660,433), paper no. 11, p. 2, last paragraph. It is noted that Applicant is trying to shift and eliminate the weight of the limitation by arguing (see Reply Brief, paper no. 18, p. 7, item 5):

"5) the allegedly dropped limitation "simultaneously" in claim 1, 1. 9 has not been improperly removed from claim 14. The term "simultaneously" as used in claim 1 refers to the ability to both clamp and release."

This argument is factually incorrect and contradicts both the specification and the physical limitations of the apparatus, because a device that is simultaneously (i.e., concurrently) clamped and released cannot ever be clamped, and therefore cannot be stabilized in any fixed position.

The rest of the arguments do nothing to factually clarify in what sense claim 1 is not impermissibly broadened or limited; the added limitations are not related to the surrender-generating limitation. Accordingly, the reissue independent claims attempt to recapture surrendered limitations and to impermissibly broaden the allowed claim.

Response to the Remand

In the present instance, the original independent claim, which was rejected by the examiner based on prior art, did not contain:

Element X: a longitudinal axis and a clamping device having an axis transverse to the longitudinal axis.

Element Y: a clamping device that can clamp and release the supporting device relative to the clamping device simultaneously about the first and second (longitudinal and transverse) axes.

To overcome the prior art rejection, the applicant rewrote this claim to add limitations X and Y. In this respect, it is particularly relevant to quote (in additions to the quotations above) from the Response in the parent application 08/813,708, paper no. 4 filed February 17, 1998, p. 6, line 17 *et seq.*,

"However, the applicant directs the examiner to page 10, lines 12-21: "Thus with one action, the rotation of handle 18 about axis 80, the clamp releases its grip to allow rotation about both axis 36 and axis 72 to provide simultaneous repositioning in the abduction and lithotomy dimensions. When the handle is released the force of Belleville washers 66 and 68 back-rotate the eccentric, snapping the handle to the normal position and allowing the Belleville washers to reinstate the clamping force on both axes.""

The applicant made the choice of inserting, i. e., adding, limitations X and Y into the original claims. The applicant chose not to prosecute further variations of the claims. At the present, on reissue, applicant is not permitted to completely delete the added limitations X and Y. See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below.

Eggert: The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal. The claims on appeal omit the surrender generating limitations (i.e., the limitation(s) added in the original prosecution to define over the art to secure allowance of the patent). This is because the limitations of **patent** claim 1 (that were added in the original application), which are represented as element X and Y above, respectively, in their entirety, are essentially absent from the reissue claims 14, 24, 48, 72, 81, 91. Therefore, the claims impermissibly recapture what was previously surrendered.

In view of *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art

rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening/narrowing scenario 3 (a), is applied in light of Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) both of which pointed out that one should look at the limitation **relied upon to define the invention over the prior art**, and determine if that limitation is omitted in the reissue claims. Note also the statement in *Clement* that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter.").

The limitations of elements X and Y in claim 1 of the original patent are germane to what was surrendered in response to a prior art rejection. Therefore, the limitations of elements X and Y of claims 1 were necessary in order to secure a patent. Similar to the facts in *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the applicant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in an area not related to the surrender. The decision in *Pannu* is on point as to the issues on appeal, because it provides an actual fact situation in which this scenario was held to be recapture. It is noted that the Appeal Brief states on page 5 that: "Furthermore, the final office action fails to consider whether the amended limitations constitute a material narrowing in other respects so that the recapture doctrine is avoided." However, in this instance, there is no apparent replacement narrowing limitation that relates to the surrender-generating limitations, which pertain to how the clamping and releasing occurs simultaneously around the longitudinal axis and the transverse axis. In the present instance, the reissue claims 14, 24, 48, 72, 81, 91 entirely omit said surrender-generating limitations, and fail to include a replacement limitation in the area of the surrender. Thus, *Pannu* is on point while *Eggert* is not, and claims 14, 24, 48, 72, 81, 91 impermissibly recapture what was previously surrendered. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Primary Examiner
Art Unit 3673

MFT 
January 11, 2005

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